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| 10/045,188 | 10/18/2001 | Chia-Hsin Li | AP110HO | 4860 |

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| EXAMINER |
|---|
| LESNIEWSKI, VICTOR D |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2152 | |

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

| | Application No. | Applicant(s) |
| --- | --- | --- |
| **Office Action Summary** | 10/045,188 | LI ET AL. |
| | Examiner | Art Unit | |
| | Victor Lesniewski | 2152 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on _05 June 2006_.

2a) ☒ This action is **FINAL**.  2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) _1-7, 9, 11, 13-23 and 28-31_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-7, 9, 11, 13-23 and 28-31_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All  b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _6/20/2006_.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

## DETAILED ACTION

1.      The amendment filed 6/5/2006 has been placed of record in the file.

2.      Claims 1-4, 7, 9, 13, 15, 16, and 20 have been amended.

3.      Claims 8, 10, 12, and 24-27 have been canceled.

4.      Claims 28-31 have been added.

5.      Claims 1-7, 9, 11, 13-23, and 28-31 are now pending.

6.      The applicant's arguments with respect to claims 1-7, 9, 11, 13-23, and 28-31 have been

considered but are moot in view of the following new grounds of rejection.


### *Response to Amendment*

7.      Claims have been amended to further define the use of a control module and user-

available function tools, as well as to show that the stand-alone program is automatically

launched on the client outside of the web browser.  The amendment proves a change in scope to

the independent claims as the independent claims now explicitly state automatically launching

the stand-alone program on the client outside of the web browser, the archive file containing a

control module, selecting at least one of a plurality of user-available function tools, and the like.

However, none of the amended claims show a patentable distinction over the prior art as

evidenced by the following new grounds of rejection.


### *Information Disclosure Statement*

8.      The IDS filed 6/20/2006 has been considered.

## *Claim Rejections - 35 USC § 112*

9.       The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10.      Claims 1-7, 9, 11, 13-23, and 28-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

11.      Independent claims 1, 15, 20, and like dependent claims recite a control module having greater access permission to the client device than the network client application. The level of access permission of the control module is seen as new matter that is not supported in the specification. The specification states that less security restrictions are placed on the stand-alone application, but is silent as to any access permissions of the control module.

12.      Independent claims 9, 15, 20, and like dependent claims recite the application including a plurality of user-available function tools. The use of user-available function tools is seen as new matter that is not supported in the specification. The specification states the use of a plurality of application options or parameters, but nowhere in the specification do these options or parameters include user-available function tools.

13.      The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14.     Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15.     Claim 7 recites "wherein selecting user-available function tools of the stand-alone application further includes" in lines 1-3. There is insufficient antecedent basis for this statement in the claim. Nowhere in claim 7, or in claim 1 from which it depends, is there previous mention of a step for selecting user-available function tools of the stand-alone application, making the scope of the claim unclear.

### Claim Rejections - 35 USC § 103

16.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

17.     Claims 1-7, 28, 29, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyker et al. (U.S. Patent Number 6,571,389), hereinafter referred to as Spyker, in view of Grate et al. (U.S. Patent Number 5,956,483), hereinafter referred to as Grate.

18.     Spyker disclosed a method for improving the manageability and usability of Java environments. In an analogous art, Grate disclosed a system for allowing users to make function calls from a web browser to a local application. Although Grate's system does not strictly deal with Java, his location application on the client device is akin to the downloaded applications of Spyker.

19.     Concerning claim 1, Spyker did not explicitly disclose using a network client application

on the client device in the fashion claimed including the feature wherein the stand-alone

application is launched on the client device outside of the network client application. However,

methods for launching local applications from a browser were well known in the art as evidenced

by Grate. It would have been obvious to one of ordinary skill in the art at the time of the

applicant's invention to modify the system of Spyker by adding the ability to utilize a network

client application on the client device in the fashion claimed including the feature wherein the

stand-alone application is launched on the client device outside of the network client application

as provided by Grate. Here the combination satisfies the need for a flexible mechanism for

passing information between a web browser and other applications running on the same user

computer. See Grate, column 1, lines 31-35. This rationale also applies to those dependent

claims utilizing the same combination.

20.     Concerning claim 29, Spyker did not explicitly disclose tools for creating greeting cards,

creating business cards, and creating a slide show presentation. However, software for creating

greeting cards, creating business cards, and creating a slide show presentation was well known in

the art at the time of the applicant's invention. Any application for creating greeting cards,

creating business cards, and creating a slide show presentation would utilize various application

options that would be specific to the application and that would allow for such creating. Since

Spyker sets forth various properties/dependencies of an application, it is clear that these

properties/dependencies would include tools for creating greeting cards, creating business cards,

and creating a slide show presentation when the application is an application for creating

greeting cards, creating business cards, and creating a slide show presentation. Thus, it would

have been obvious to one of ordinary skill in the art at the time of the applicant's invention to

modify the system of Spyker by adding the ability to utilize tools for creating greeting cards,

creating business cards, and creating a slide show presentation.

21.      Thereby, the combination of Spyker and Grate discloses:

- <Claim 1>

  A method for installing and launching a stand-alone application on a client device,

  through a distributed network, said stand-alone application contained on a server, said

  method having the steps comprising: using a network client application on the client

  device to access the server through the network (Grate, column 4, lines 41-50); using the

  network client application to select said stand-alone application (Grate, column 2, lines

  14-28); downloading and opening an archive file from said network to said client device,

  said archive file containing a plug-in control module and said stand-alone application

  (Spyker, column 9, lines 5-11 and column 12, lines 30-50); granting said plug-in control

  module permission for operation, said control module having greater access permission to

  said client device than said network client application (Spyker, column 12, lines 54-63);

  having said plug-in module launch said stand-alone application on the client device

  outside of said network client application (Grate, column 2, lines 29-44).

- <Claim 2>

  The method as recited in claim 1, wherein the stand-alone application is configured to

  access native libraries of the archive file (Spyker, column 15, lines 12-20).

- \<Claim 3\>

  The method as recited in claim 31, wherein the network port is a TCP/IP port (Spyker, column 7, line 66 through column 8, line 3 and Grate, column 2, lines 37-39).

- \<Claim 4\>

  The method as recited in claim 1, wherein the stand-alone application is a Java application, the Java application configured to be executed by a Java virtual machine of an operating system of the client device (Spyker, column 1, lines 22-44).

- \<Claim 5\>

  The method as recited in claim 1, wherein the archive file is a .cab file, the .cab file including the application and a control module (Spyker, column 3, line 65 through column 4, line 2).

- \<Claim 6\>

  The method as recited in claim 5, wherein the application is a Java application and the .cab file includes native libraries, the native libraries configured to standardize an output of the Java application across platforms (Spyker, column 15, lines 12-20 where the use of the JAR type is akin to the use of a CAB type file).

- \<Claim 7\>

  The method as recited in claim 1, wherein selecting user-available function tools of the stand-alone application further includes: linking to an HTML page the HTML page including an object containing version information of an archive file (Spyker, column 9, lines 23-33 and column 10, lines 13-24 and Grate, column 3, lines 45-52).

- <Claim 28>

  The method of claim 1, wherein: in the step of using the network client application to

  select said stand-alone application, said network client application further selects among

  a plurality of user-available function tools; in said step of downloading and opening an

  archive file from said network to said client device, said archive file is configured to

  include selected user-available function tools and exclude non-selected user-available

  function tools (Spyker, column 11, line 42 through column 12, line 12).

- <Claim 29>

  The method of claim 28, wherein said plurality of user-available function tools include at

  least function tools for creating greeting cards, creating business cards, and creating a

  slide show presentation (obviousness as discussed above).

- <Claim 31>

  The method of claim 1, further comprising: using the network client application to pass

  parameters to a network port in communication with said network (Grate, column 2, lines

  29-37); having the stand-alone application listen to the port and implement the

  parameters intended for the stand-alone application (Grate, column 2, lines 37-44).

Since the combination of Spyker and Grate discloses all of the above limitations, claims 1-7, 28,

29, and 31 are rejected.


22.      Claims 9, 11, 13, 15, 17-23, and 30 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Spyker in view of Grate, as applied above, further in view of Giroir et al. (U.S.

Patent Number 6,854,006), hereinafter referred to as Giroir.

23.    The combination of Spyker and Grate disclosed a system for the improved manageability

and usability of Java environments in which users can make function calls from a web browser to

a local application. In an analogous art, Giroir disclosed a system for allowing target

applications to be locally selected and easily accessed. Both systems deal with the downloading

of Java-based applications.

24.    Concerning claims 9, 15, 20, and 30, the combination of Spyker and Grate did not

explicitly disclose determining if the latest version of the stand-alone application is present on

the client device. Although Spyker states the ability to retrieve a latest version of the properties

for an application (see column 4, lines 64-67), he is not explicit about checking the version of the

application. However, a major focus of Giroir's system is to check for the latest version on the

client. It would have been obvious to one of ordinary skill in the art at the time of the applicant's

invention to modify the combination of Spyker and Grate by adding the ability to determine if

the latest version of the stand-alone application is present on the client device as provided by

Giroir. Here the combination satisfies the need for a Java environment that is easier to use. See

Spyker, column 4, lines 3-10. This rationale also applies to those dependent claims utilizing the

same combination.

25.    Thereby, the combination of Spyker, Grate, and Giroir discloses:

- <Claim 9>

    A method for launching a stand-alone program on a network client, the stand-alone

    program being accessed through a web browser on the network client, the method

    comprising: using the web browser to access a server (Grate, column 4, lines 41-50), said

    server containing the stand-alone program (Spyker, column 11, lines 43-47); using the

web browser to select among a plurality of user-available function tools of the stand-alone application (Spyker, column 11, line 42 through column 12, line 12); linking to a page on the server, the page containing version information of a server archive file (Spyker, column 10, lines 13-24 and column 11, line 56 through column 12, line 29); determining if a client archive file is present on the client, the determining further including; inspecting the client archive file if the client archive file is present to ascertain if the client archive file is the same version as the server archive file (Giroir, column 9, lines 17-28); and downloading the server archive file to the client if the client archive file is not present, or if the client archive file is not the same version as the server archive file, or if the client archive file does not include any of the selected user-available function tools (Spyker, column 12, lines 30-50); and automatically launching the stand-alone network program on the client outside of said web browser (Grate, column 2, lines 29-44).

- <Claim 11>

The method as recited in claim 9 further including: executing the application, the executing further including, accessing native libraries, the native libraries installed by the archive file (Spyker, column 15, lines 12-20).

- <Claim 13>

The method as recited in claim 9, wherein the archive file is a .cab file, the .cab file containing a control module accessible by said web browser, the control module configured to launch said stand-alone program (Spyker, column 3, line 65 through column 4, line 2).

• <Claim 15>

A system for installing and launching stand-alonge application through a network, the

system comprising: a server (Spyker, figure 2, item 47), the server including an

application contained in a server archive file (Spyker, column 8, lines 57-59), the

application including a plurality of user-available function tools (Spyker, column 9, lines

34-52), the server configured to link to a page containing version information of the

server archive file (Spyker, column 9, lines 23-33 and column 10, lines 13-24), the server

further configured to allow a user to select the user-available function tools of the

application (Spyker, column 11, lines 42-43); a web browser (Spyker, column 1, lines 45-

48 and Grate, column 4, lines 41-50), and a client (Spyker, figure 2, item 10 and Grate,

column 4, lines 41-50), the client in communication with the server through a network

port by means of the web browser (Spyker, figure 2, item 50 and Grate, column 4, lines

41-50), the client inspected by the server to determine if a client archive file is present

and current by comparing the version information of the server archive file with version

information of the client archive file (Giroir, column 9, lines 17-28 and Spyker, column

11, line 56 through column 12, line 29), wherein if the client archive file is not present or

not current, the server archive file is downloaded to the client, the client archive file

including the stand-alone application and a browser-accessible control module (Spyker,

column 9, lines 5-11 and column 12, lines 30-50); said control module having greater

permission levels on said client than said web browser (Spyker, column 12, lines 54-63),

said control module being configured to automatically launch said stand alone application

outside of said web browser (Grate, column 2, lines 29-44); said stand-alone application

further configured to listen to the network port such that any of the user-available

function tools selected by a user are transmitted to the stand-alone application through the

software network port (Grate, column 2, lines 29-44) and the stand-alone application

configures itself to include the selected user-available function tools and to exclude the

unselected user-available function tools from among said plurality of user-available

function tools (Spyker, column 11, line 42 through column 12, line 12).

- <Claim 17>

  The system as recited in claim 15, wherein the application is a Java application

  containing printing functionality (Giroir, column 7, lines 59-62).

- <Claim 18>

  The system as recited in claim 17, wherein the Java application uses a Java virtual

  machine of an operating system of the client (Spyker, column 1, lines 22-44).

- <Claim 19>

  The system as recited in claim 17, wherein the printing functionality is regulated by

  native libraries, the native libraries included in the client archive file (Spyker, column 15,

  lines 12-20).

- <Claim 20>

  A computer readable media containing program instructions for installing and launching

  a stand-alone application on a client device, through a distributed network, the

  application contained on a server, the computer readable media comprising: program

  instructions for accessing the server through the network by using a network port on the

  client device (Grate, column 4, lines 41-50); program instructions for selecting at least

one of a plurality of user-available function tools of the application (Spyker, column 11,

line 42 through column 12, line 12); program instructions for determining if the latest

version of the application is present on a client (Giroir, column 9, lines 17-28); program

instructions for downloading and opening an archive file containing the latest version of

the application if the latest version of the application is not present on the client device,

said archive file further containing a control module having full access to said client

device (Spyker, column 9, lines 5-11 and column 12, lines 30-50); program instructions

for launching the control module and having the control module launch the stand-alone

application on the client device (Spyker, column 12, lines 30-50 and Grate, column 2,

lines 29-44); and program instructions for passing selections of user-available function

tools to the network port (Grate, column 2, lines 29-37); for having the application listen

to the port and provide the selected user-available function tools and not provide

unselected user-available function tools from among said plurality of user-available

function tools (Spyker, column 11, line 42 through column 12, line 12 and Grate, column

2, lines 37-44).

- <Claim 21>

  The computer readable media as recited in claim 20, wherein the program instructions for

  passing parameters to a port further includes: program instructions for configuring the

  application to listen to the port; and program instructions for individually sending the

  parameters over the port, the parameters being sent by a control module (Grate, column

  2, lines 29-44).

- <Claim 22>

    The computer readable media as recited in claim 20, wherein the port is a TCP/IP port

    (Spyker, column 7, line 66 through column 8, line 3 and Grate, column 2, lines 37-39).

- <Claim 23>

    The computer readable media as recited in claim 20, wherein the application is a Java

    application, the Java application configured to be executed by a Java virtual machine of

    an operating system of the client (Spyker, column 1, lines 22-44).

- <Claim 30>

    The method of claim 1, further comprising: determining if the latest version of said stand-

    alone application is present on the client device (Giroir, column 9, lines 17-28); and

    wherein in said step of downloading and opening an archive file from said network to

    said client device, said archive file is configured to contain the latest version of said

    stand-alone application if the latest version of the stand-alone application is not present

    on the client device (Spyker, column 12, lines 30-50).

Since the combination of Spyker, Grate, and Giroir discloses all of the above limitations, claims

9, 11, 13, 15, 17-23, and 30 are rejected.


26.     Claims 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spyker

in view of Grate in view of Giroir, as applied above, further in view of Schmidt et al. (U.S.

Patent Number 6,535,894), hereinafter referred to as Schmidt.

27.     The combination of Spyker, Grate, and Giroir disclosed a technique where Java programs

can be executed without relying on the use of a browser to provide a run-time environment, in

which the client can be checked for the latest version before installation. In an analogous art, Schmidt disclosed a method for updating archive files. Both methods deal primarily with archive files in a Java-based networking environment.

28.     Concerning claim 14, the combination of Spyker, Grate, and Giroir did not explicitly disclose the use of a digital signature. However, Schmidt disclosed an archived file that can contain digital signatures. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Spyker, Grate, and Giroir by adding the ability to use digital signatures as provided by Schmidt. Again, the combination satisfies the need for a Java environment that is easier to use. See Spyker, column 4, lines 3-10.

29.     Concerning claim 16, the combination of Spyker, Grate, and Giroir did not explicitly disclose the use of INF files within the archived files. However, Schmidt's JAR file, related to a CAB file, contains a sub-directory for INF information that aids in the installation and launching of the application. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the combination of Spyker, Grate, and Giroir by adding the ability to use INF files as provided by Schmidt. Again, the combination satisfies the need for a Java environment that is easier to use. See Spyker, column 4, lines 3-10.

30.     Thereby, the combination of Spyker, Grate, Giroir, and Schmidt discloses:

* <Claim 14>

    The method as recited in claim 13, wherein the control module is further configured to be digitally signed (Schmidt, column 9, lines 3-5).

- <Claim 16>

The system as recited in claim 15, wherein the control module individually transmits to

the port the user-available function tools selected by the user (Grate, column 2, lines 29-

44), and the client and server archive files are .cab files, the .cab files including .INF

files, the .INF files including a launcher application containing the control module

(Spyker, column 3, line 65 through column 4, line 2 and Schmidt, column 8, lines 53-67).

Since the combination of Spyker, Grate, Giroir, and Schmidt discloses all of the above

limitations, claims 14 and 16 are rejected.


## *Conclusion*

31.     The applicant's amendment necessitated the new grounds of rejection presented in this

office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). The

applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

32.     Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987. The examiner can normally be reached on Monday through Thursday.
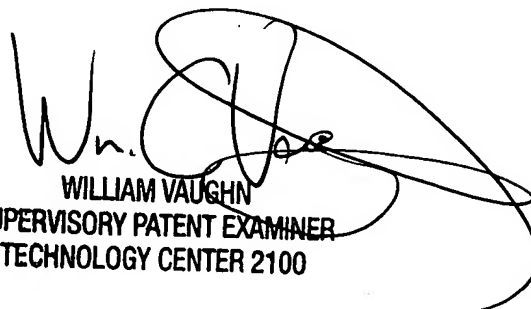
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Victor Lesniewski
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